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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,530	12/28/2000	Denis Khoo	6000-011-52(IND-105)	6669
7590 03/21/2005			EXAMINER	
PIPER RUDNICK, LLP 1200 NINETEENTH STREET NW WASHINGTON, DC 20036-2412			SALCE, JASON P	
			ART UNIT	PAPER NUMBER
			2611	
DATE MAILED: 03/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,530	KHOO ET AL.	
	Examiner	Art Unit	
	Jason P Salce	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9-12,17,18,22,44-47,71,73,74,76,78 and 80-137 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,9-12,17,18,22,44-47,71,73,74,76,78 and 80-137 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/05 and 11/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 9-12, 17-18, 22, 44-47, 71, 73-74, 76 and 78 have been considered but are moot in view of the new ground(s) of rejection.

New claims 80-137 are also rejected.

The declaration filed on 12/08/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Candelore reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Eldering (or Candelore) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Exhibit I is unintelligible, and is therefore insufficient evidence since the examiner cannot determine if the information in the figure provides support for all the limitations in the claims.

Furthermore, none of the exhibits provide (as stated in the affidavit) a date prior to July 9, 1997. Exhibit I only attempts to provide evidence of a date prior to December 3, 1998. Therefore, even if the affidavit were sufficient, it would only pre-date the Eldering reference, not the Candelore reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Candelore reference to either a constructive reduction to practice or an actual reduction to practice.

“Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence” (MPEP 715.07(a)). Applicant only states that the invention was diligently reduced to practice by specific means, but provides no evidence of writing of code, hiring of several software and hardware engineers and the management of said engineers.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 9-12, 17-18, 22, 44-47, 71, 73-74, 76, 78 and 80-85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 44 state receiving and/or displaying customized video content and customized advertising content at a reception device. The examiner has failed to find displaying and/or receiving both pieces of content at the reception device in the specification. After a telephone interview with applicant's representative Lisa Norton on 3/14/2005, an agreement was reached to amend the claims in a response following this Final Office Action, because the specification only supports one type of content being received and displayed at a given time (either video content (movie) or a video advertisement (infomercial)).

For the remainder of the office action, the examiner will assume that only one type of content (video content or advertising content) is received and displayed. Therefore, if the limitation in the claims state, "a video component and customized advertising having a video component", the examiner will assume this limitation as "customized advertising content".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 9-12, 17-18, 22, 44-47, 71, 73-74, 76, 78, 80-90, 92-103 and 105-137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore (U.S. Patent No. 6,057,872) in view of Alexander et al. (U.S. Patent No. 6,177,931).

Referring to claim 1, Candelore discloses providing a reward for receiving content to at least one viewer over a data network (see Column 3, Lines 40-49).

Candelore also discloses transmitting the content over the data network to a reception device (see terminal 160 in Figure 1 and Column 6, Lines 17-26).

Candelore also discloses presenting on the reception device the content for a presentation period (Column 6, Lines 35-36).

Candelore also discloses providing a reward if the presenting of the content satisfies a predetermined condition associated with the reward (see Column 4, Lines 30-37 and Figure 7B).

Candelore also teaches that the rewards can be sent to the viewer based on a viewer's profile (see Column 4, Lines 16-30), but fails to disclose that the content is transmitted to the reception device in accordance with a customized schedule based on information about the at least one viewer.

Alexander teaches a targeted advertisement system, which customizes video programming, as well as video advertisements (content) to a specified user using a user profile, which is based off the user's viewing habits (see Column 32, Lines 23-67 and Column 33 and 34, Lines 1-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the television reward system, as taught by Candelore, using the targeted advertising system, as taught by Alexander, for the purpose of providing customized advertising to the viewer (see Column 2, Lines 20-21 of Alexander).

Claim 9 corresponds to claim 1, where Candelore further discloses requesting, by the reception device over the data network, the content from a server (see headend 110 in Figure 1 and Column 2, Lines 4-9 for a VOD service (which is one of many different services provided by Candelore), which allows a user to request content from a server).

Candelore also discloses retrieving, by the content providing server, the content requested (see again Column 2, Lines 4-9).

Candelore also discloses transmitting the content to the content reception device through the data network (see again Column 2, Lines 4-9).

Note that selecting a video-on-demand movie by a user consists of requesting the movie (by the user), retrieving the movie (from a video server), and transmitting the movie back to the user.

Also note the rejection of claim 1, for how Alexander adds the functionality of providing "customized content" to the viewer.

Claim 10 corresponds to claim 9, where Alexander discloses transmitting, by the reception device, information regarding characteristics of the at least one viewer, and storing, by the server, the information regarding characteristics of the at least one viewer (see Column 29, Lines 14-21).

Claim 11 corresponds to claim 9, where Alexander discloses that the reception device requests customized content based on a demographic of the at least one viewer (see Column 30, Lines 53-58 and note that if the EPG is customized, then the user would inherently be requesting "customized content").

Claim 12 corresponds to claim 1, Alexander discloses displaying the content on an intelligent television (see Column 8, Lines 66-67 and Column 9, Line 1).

Claim 17 corresponds to claim 1, Alexander discloses displaying the customized content for presentation period sufficient to receive at least a portion of the customized content (see Figure 1, for the program "REMEMBER" being displayed from 9pm to 9:30pm). Therefore, since the EPG is customized (see the rejection of claim 11), the customized program "REMEMBER", will be displayed for the time period specified by the EPG.

Claim 18 corresponds to claim 1, Candelore discloses the predetermined condition associated with the reward is defined to require that a presentation period exceed a predetermined threshold (see Figure 7B and Column 11, Lines 41-67 and Column 12, Lines 1-56).

Claim 22 corresponds to claim 1, Candelore discloses providing a monetary award to the viewer (Column 9, Lines 7-14).

Referring to claim 44, see rejection of claim 1. Also note that claim 44 further recites that the reward is provided based on the information about the at least one viewer (for example, note that the reward is provided by Candelore only if the user watches the content for a specified period of time (see Figure 7B), therefore the reward is provided based on the information of at least one viewer).

Referring to claim 45-46, see the rejection of claim 11.

Referring to claim 47, see the rejection of claim 12.

Referring to claim 71, see rejection of claim 9.

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Referring to claims 73, Candelore discloses transmitting the reward from headend 110 in Figure 1, which also provides VOD content to the user. Also note that Alexander transmits "customized content" from the headend (see the rejection of claim 1).

Referring to claim 74, see rejection of claim 1.

Referring to claims 76 and 78, see the rejection of claim 18.

Referring to claim 80, see the rejection of claim 11.

Referring to claim 81, see the rejection of claim 22.

Referring to claim 82, see the rejection of claim 11.

Referring to claims 83-85, see the rejection of claims 73-74 and 78, respectively.

Referring to claims 86-90, 92-95 and 97-98, see the rejection of claims 1, 9-12, 17-18 and 22.

Referring to claim 96, Candelore discloses that the reward can be customized to characteristics of a viewer (see Column 4, Lines 16-30).

Referring to claims 99-103 and 105-111, see the rejection of claims 86-90 and 92-98, respectively.

Referring to claims 112-124, see the rejection of claims 86-90, 22 and 92-98, respectively. Note that claim 117 differs from the previously newly added claim, which relates to entering the viewer into a sweepstakes. Claim 117 states a monetary reward "or", and therefore reads on claim 22.

Referring to claims 125-137, see the rejection of claims 86-90, 22 and 92-98, respectively. Note that claim 130 differs from the previously newly added claim, which

relates to entering the viewer into a sweepstakes. Claim 130 states a monetary reward "or", and therefore reads on claim 22.

4. Claims 91 and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore (U.S. Patent No. 6,057,872) in view of Alexander et al. (U.S. Patent No. 6,177,931) in further view of Broadwin et al. (U.S. Patent No. 5,929,850).

Referring to claims 91 and 104, Candelore and Alexander teach all of the limitations in claims 86 and 99, respectively. However, Candelore and Alexander fail to teach that the reward also includes a right for a reward recipient to enter into a sweepstakes.

Broadwin discloses a system that provides advertising in the form of an entry form for a sweepstakes (see Figure 19 and Column 18, Lines 56-64).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the advertising system, as taught by Candelore and Alexander, using the sweepstakes entry form, as taught by Broadwin, for the purpose of providing a more simplified mechanism for displaying interactive advertising content (see Column 18, Lines 51-52 of Broadwin).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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CHRIS GRANT
PRIMARY EXAMINER